

Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference M/44079-PCT	FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. PCT/EP2004/003425	International filing date (day/month/year) 31.03.2004	Priority date (day/month/year) 01.04.2003
International Patent Classification (IPC) or national classification and IPC		
Applicant BASF AKTIENGESELLSCHAFT		

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 7 sheets, including this cover sheet.

3. This report is also accompanied by ANNEXES, comprising:

a. ☒ (sent to the applicant and to the International Bureau) a total of 3 sheets, as follows:

☒ sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).

☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.

b. ☐ (sent to the International Bureau only) a total of _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

<input checked="" type="checkbox"/> Box No. I	Basis of the report
<input type="checkbox"/> Box No. II	Priority
<input type="checkbox"/> Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/> Box No. IV	Lack of unity of invention
<input checked="" type="checkbox"/> Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
<input type="checkbox"/> Box No. VI	Certain documents cited
<input checked="" type="checkbox"/> Box No. VII	Certain defects in the international application
<input checked="" type="checkbox"/> Box No. VIII	Certain observations on the international application

Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/003425

Box No. I Basis of the report

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language _____, which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the **elements** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:
- ☐ the international application as originally filed/furnished
- ☒ the description:
- pages 1-21 _____ as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☒ the claims:
- nos. _____ as originally filed/furnished
- nos.* _____ as amended (together with any statement) under Article 19
- nos.* 1-22 _____ received by this Authority on 31.01.2005 with letter of 31.01.2005
- nos.* _____ received by this Authority on _____
- ☐ the drawings:
- sheets _____ as originally filed/furnished
- sheets* _____ received by this Authority on _____
- sheets* _____ received by this Authority on _____
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/003425

Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	6, 15, 20	YES
	Claims	1-5, 7-14, 16-19	NO
Inventive step (IS)	Claims	6, 20	YES
	Claims	1-5, 7-19, 21, 22	NO
Industrial applicability (IA)	Claims	1-22	YES
	Claims		NO
2. Citations and explanations (Rule 70.7)			
1. Reference is made to the following documents:			
D1: WO-A-00/47698			
D2: WO-A-01/85874			
D3: WO-A-97/23586			
D4: EP-A-O 244 616.			
2. The amended independent main claim in the present application contains <u>nothing to restrict</u> the proportion of the polyalkene amine in the claimed polyalkylene amine formulation, and said polyalkylene amine formulation must comprise <u>at least one</u> of the low-temperature properties a), b) and/or c) [i.e. not necessarily all three at the same time or at least c)].			
It follows from this observation that the subject matter of the amended claims fails to meet the requirements of PCT Article 33(2) and/or (3) in respect of the respective disclosures and/or teachings according to D1 to D4 (see points 2.a to 2.d below).			
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INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/003425

Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
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- 2.a The subject matter of claims 1-5, 7-13 and 16-19 lacks novelty (PCT Article 33(2)) and the subject matter of claim 15 does not involve an inventive step (PCT Article 33(3)) relative to the disclosure of document D1 (see the relevant passages cited in the search report).
- 2.b The subject matter of claims 1-5, 7-12 and 16-19 lacks novelty (PCT Article 33(2)) and the subject matter of claims 13 and 15 does not involve an inventive step (PCT Article 33(3)) relative to the disclosure of document D2 (see the relevant passages cited in the search report).
- 2.c The subject matter of claims 1-5, 7-12 and 14 lacks novelty (PCT Article 33(2)) and the subject matter of claims 13 and 21 does not involve an inventive step (PCT Article 33(3)) relative to the disclosure of document D3 (see the relevant passages cited in the search report).
- 2.d The subject matter of claims 1-5, 7-14, and 21 and 22 lacks novelty (PCT Article 33(2)) and the subject matter of claim 15 does not involve an inventive step (PCT Article 33(3)) relative to the disclosure of document D4 [see the relevant passages cited in the search report; moreover, in the present application it is stated (see the "pour point" of the prior art according to D4, table B, under "PIBA alt") that formulations

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INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/003425

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according to D4 comprise at least the low-temperature property b) of the first independent claim.

3.a The combinations of features according to dependent claim 6 and independent claim 20 are not known from the available prior art, nor are they rendered obvious thereby (PCT Article 33(2) and (3)).

3.b The combination of features according to independent claim 15 is not known from the available prior art (PCT Article 33(2)).

4. The claimed subject matter is considered to be industrially applicable (PCT Article 33(4)).

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

1. At the end of page 19 of the present application, part of the description relating to production example 1 has been omitted.

Page 19 ends with "examples of lubricants that can be used as additives as per the invention include oils and greases for" and page 20 begins with "the cloud point and the pour point were measured for each of the two formulations"; page 20 (line 9) then refers to "production example 2" although "production example 1" is not mentioned in pages 1-19, appearing only on page 21, where the following is stated under "production example 3": "production example 1 was repeated but...".

2. Contrary to PCT Rule 5.1(a)(ii), the description does not cite documents D1 to D3 or indicate the relevant prior art disclosed therein.
3. The description is not consistent with the amended claims (PCT Rule 5.1(a)(iii)).

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/003425

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

1. Claim 1 fails to comply with the requirements of PCT Article 6 because the subject matter for which protection is claimed is not clearly defined. Said claim attempts to define the polyalkylene amine formulation in terms of the result which is to be achieved [i.e. at least one of the low-temperature properties a), b) and/or c)] but in so doing merely states the problem to be solved without giving the necessary technical features for achieving this result (see for example the present application, page 10, lines 33-35; page 11, lines 14-17).
2. Logically, "in the region of" should be deleted from claim 1 (PCT Article 6).
3. In the first claim, the expression "no crystalline precipitation after storage" lacks clarity because the storage period has not been defined (see page 3, lines 16-19) (PCT Article 6).
4. The first reference to L1 and L2 is in claim 5 and, in consequence, claim 20 should refer back to "one of claims 5 to 6" and not to "one of claims 3 to 6" (PCT Article 6)